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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/584,045	05/30/2000	Andrew Hausman	336001-2025.1	9896
20999 7590 04/13/2009 FROMMER LAWRENCE & HAUG 745 FIFTH AVENUE- 10TH FL.. NEW YORK, NY 10151				
EXAMINER				
ROBINSON, KITO R				
ART UNIT		PAPER NUMBER		
3692				
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**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

## Office Action Summary

**Application No.**

09/584,045

**Applicant(s)**

HAUSMAN, ANDREW

**Examiner**

KITO R. ROBINSON

**Art Unit**

3692

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 22 February 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 19 and 35 is/are pending in the application.
- 4a) Of the above claim(s) 1-18, 20-34 & 36-40 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 7, 19 and 35 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 01 April 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
- Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)
- Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

## DETAILED ACTION

### Status of Claims

1. This action is in reply to the restriction/election filed on 22 February 2008.
2. Claims 19 & 35 have been amended.
3. Claims 1-18, 20-34 & 36-40 have been canceled.
4. Claims 19 & 35 are currently pending and have been examined.

### Claim Rejections - 35 USC § 101

5. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

6. Claim 35 is rejected under 35 U.S.C. § 101 based on Supreme Court precedent, and recent Federal Circuit decisions, a § 101 process must (1) be tied to a particular machine or apparatus or (2) transform underlying subject matter (such as an article or materials) to a different state or thing. *Diamond v. Diehr*, 450 U.S. 175, 184 (1981); *Parker v. Flook*, 437 U.S. 584, 588 n.9 (1978); *Gottschalk v. Benson*, 409 U.S. 63, 70 (1972); *Cochrane v. Deener*, 94 U.S. 780,787-88 (1876). The process steps in claim (35) are not tied to a particular machine or apparatus nor do they execute a transformation. Thus, they are non-statutory.

(‘A process is...an act, or a series of acts, performed upon the subject-matter to be transformed and reduced to a different state or thing.’).<sup>7</sup> A claimed process involving a fundamental principle that uses a particular machine or apparatus would not pre-empt uses of the principle that do not also use the specified machine or apparatus in the manner claimed. And a claimed process that transforms a particular article to a specified different state or thing by applying a fundamental principle would not pre-empt the use of the principle to transform any other article, to transform the same article but in a

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manner not covered by the claim, or to do anything other than transform the specified article." (In re Bilski, 88 USPQ2d 1385, 1391 (Fed. Cir. 2008)).

The recitation of specific machine or particular transformation of specific article does not transform unpatentable principle into patentable process if recited machine or transformation constitutes mere "insignificant post-solution activity." (In re Bilski, 88 USPQ2d 1385, 1385 (Fed. Cir. 2008)). Examples of insignificant post-solution activity include data gathering and outputting. Furthermore, the machine or transformation must impose meaningful limits on the scope of the method claims in order to pass the machine-or-transformation test.

The claims recite "displaying on a device" which constitute mere "insignificant post-solution activity. Furthermore, the claims recite "automatically generating," however there is no clear tie to a machine or apparatus for this step.

#### **Claim Rejections - 35 USC § 103**

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

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9. Claims 19 & 35 are rejected under 35 U.S.C. 103(a) as being unpatentable over Sandhu et al. US 2003/0033212 A1, hereafter Sandhu in view of Potter et al. US Patent Number 5,787,402, hereafter Potter.

**As per claim 19 & 35**

Sandhu discloses:

- *a plurality of user stations, each including at least one user computer, at least one input device and at least one display device (see at least the Abstract);*
- *at least one trade execution computer capable of executing forwards trades from forwards orders in the trading system, the at least one trade execution computer and the plurality of user stations communicating over a communications network (see at least the Abstract)*
- *a computer readable medium which stores computer programming executed by the at least one trade execution computer to cause the at least one trade execution computer to carry out a method means for executing a forwards spread trade (see at least paragraph 205) from the forwards orders in the trading system comprising a first leg forwards trade and a second leg forwards trade (see at least paragraph 0418, 0421 and 0422), and a price spread comprising the difference between prices of the first and second leg forwards trades,, the method carried out by the at least one trade execution computer comprising (see at least paragraph 0886)*
- *in response to a request entered by the at least one input device of a party at a user station to execute the automatically-generated order displayed on the at least one display device of that party, executing the forwards spread trade including executing among the party and two other parties the first leg forwards trade at the first price and the second leg forwards trade at the second price (see at least paragraph 192, 193, 202 & 205)*

Sandhu does not disclose the following, however Potter does:

- *means-for automatically generating from the forwards orders in the trading system one of (a) a forwards spread order including a spread price representing a difference between prices of potential first and second leg forwards trades and an order relating to one of the first and second*

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*leg forwards trades and (b) a forwards spread order, the automatically-generated order not being initiated by a party (see at least claim 25);*

- *causing the at least one display device of user stations to display the automatically-generated order (see at least figure 1).*

It would have been obvious to one of ordinary skill in the art at the time of the invention to [combine/modify] the method of Sandhu with the technique of Potter because it is a quick and easy way to calculate the difference among the legs.

### Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to **KITO R. ROBINSON** whose telephone number is **(571)270-3921**. The examiner can normally be reached on Monday-Friday 7:30am-5:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, **Kambiz Abdi** can be reached on **(571) 272-6702**. The fax phone number for the organization where this application or proceeding is assigned is **571-273-8300**.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or **571-272-1000**.

/Kito R Robinson/  
Examiner, Art Unit 3692

08 April 2009

/Susanna M. Diaz/  
Primary Examiner, Art Unit 3692